

**BEST AVAILABLE COPY**Application No.: 10/617894Case No.: 58670US004**REMARKS**

Claims 1-65 are pending in the present application. Claims 23-26, 44, and 65 were examined and rejected. Claims 1-22, 27-43, and 45-64 were withdrawn from consideration. In particular, it is again noted that claim 1 was declared to be not examined, despite the fact that elected claims 23-26 and 44 all depend from claim 1 and the elements of claim 1 were in fact examined for making the present rejections.

By this amendment, claims 1 and 65 have been amended. Support for the amendments to the claims may be found in FIGs. 1-27 and paragraphs [0058] and [0077], as merely examples, and no new matter is believed to be added by these amendments. Accordingly, Applicants respectfully request entry of the claim amendments and also request consideration of claim 1, as will be discussed below.

Applicants request reconsideration and withdrawal of the present objections and rejections based on the following comments.

**Objections**

The Office Action has maintained an objection to claims 23-26 and 44 because these claims "depend from a nonelected claim 1." Applicant respectfully traverses this objection and respectfully asks for reconsideration. Applicant previously noted that the restriction requirement issued by the Patent Office grouped independent claim 1 separately from dependent claims 23-26 and 44 and that such grouping is not proper and does not make sense. As a consequence of this improper grouping, the patent Office appears to be forcing a requirement that Applicant "correct" dependent claims 23-26 and 44 by amending dependent claims due to a restriction requirement. This is contrary to established Patent Office practice for restrictions and is prejudicial to the Applicant by *de facto* not allowing an original presentation of claims. Although the Office Action states that this is "not seen" to be contrary to proper restriction practice, such a subjective standard is not dispositive.

In order to provide predictability and consistency in the examination process, the Patent Office regulates restriction practice through established procedures set forth by the M.P.E.P. No real support for this unorthodox restriction requirement (i.e., restricting dependent claims from independent claims where the restriction was not an election of species requirement)

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was given in the Office Action according to requirements set forth in the M.P.E.P. The restriction merely asserted that inventions I and II were "unrelated" based on an allegation that "pore formation is required for the foamed polymeric article while it is not required for the non-formed polymeric article" and cited sections 806.04 and 808.01 of the M.P.E.P. It is noted that one of these cited sections in the "restriction" (i.e., 806.04) relates to election of species, which was not issued in this case. Rather, a restriction requirement was issued. Thus, it appears that the basis for making the restriction requirement of inventions I and II was in part flawed and is not consistent with the requirements of the M.P.E.P. Accordingly, Applicant asks that the Patent Office provide actual support and reasons for the propriety of this objection, rather than citing a section that actually is an improper basis for the actual restriction issued.

Moreover, this reasoning appears to ignore the actual claim language, but rather improperly extrapolates to apparently reason that the process of forming the polymeric material itself is being claimed here. Only an article made of a polymer is claimed, whether that article is constructed with a polymer or a specific polymer such as polymeric foam.

Furthermore, the present Office Action asserts that the products of claims 1 and claims 23-26, 44 and 65 are "independent from each other and related to different product [sic], i.e., unfoamed material vs. foamed material." Applicant respectfully submits that this assertion is not correct as argued above. That is, claim 1 encompasses polymer articles made of unfoamed and foamed materials. Nowhere does claim 1 limit the article to only unfoamed material as alleged in the Office Action. Thus, Groups I and II were further not necessarily independent or distinct *as claimed*, further evincing that the restriction was improper. Accordingly, reconsideration and withdrawal of the objections is requested, and claim 1, at the least, should be included in the scope of consideration for examination.

Of a practical note, also, if dependent claims 23-36 and 44 were amended, for example, to include the elements of independent claim 1, examination of the claims still involves searching for all of the elements of claim 1, thus belying the assertion that there would be a serious burden of examination for the Examiner. Moreover, all of the rejections of claims 23-26 and 44 in the present Office Action have necessarily compared the cited prior art to elements of independent claim 1. Thus, claim 1 has, in fact, already been examined.

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**Rejections**

Claims 23-26, 44, and 65 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,797,361. Applicants respectfully traverse this rejection for the following reasons.

The cited reference does not teach or suggest a polymer article having the structural features of a polymer sheet including "a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern." Similarly, with respect to independent claim 65, the cited reference does not teach or suggest "[a]n elongate foam strip" featuring "a surface pattern provided in an area that has been formed to a desired shape under pressure with a first area partially compressed area and a second area compressed one of more or less than the first area." Neither claims 1-24 nor Figures 1 and 2 of the cited reference disclose a surface pattern having the above claimed features, but merely teaches a combination of foam strips 1a, 1b, 1c joined at a cold welded seam 4 that is a single, fully compressed area effecting a seam by pressure rollers or wheels 3. Accordingly, claims 1, 23-26, 44 and 65 are allowable over the cited reference and the rejection should be withdrawn. Notwithstanding, in an effort to expedite prosecution, Applicants would be willing to file a terminal disclaimer over the claims of U.S. Patent No. 6,797,361.

Claim 23-26, 44, and 65 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. 10/617,893. Applicants would be willing to file a terminal disclaimer over any claims issued in copending Application No. 10/617,893.

Claims 23, 24, and 26 were rejected under 35 U.S.C. §102(b) as being anticipated by Bambara et al. (U.S. Pat. No. 5,350,544). Applicants respectfully traverse this rejection for the following reasons.

The cited sections and figures of Bambara et al. asserted as teaching the features of claims 1, 23, 24, and 26 (i.e., Fig. 2 and col. 4, lines 40-42) do not teach the claimed features of the amended claims. Specifically, Bambara teaches heating a foam sheet 32 to form a heated surface

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area 36 on the foam sheet 32, thereby causing a slight foam post-expansion rise on the heated surface area 36. A cold metal die 38 with a design is positioned above the heated area 36 to form a foam sheet product 32 having a three-dimensional, foam-tread-wear surface 40. The post-heat expansion of the foam cells on the foam board stock 32 are then taught by Bambara to rise to fill in the cavities of the cold die 38 and to form, upon cooling, the three-dimensional, foam tread design.

In light of foregoing differences, which were acknowledged in the present Office Action, the resultant structure of Bambara would be quite different from the claimed polymer sheet including "a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern." The structure of Bambara is necessarily an expanded structure since the reference expressly teaches heated expansion into a mold, whereas the present claimed article includes compressed areas that effect a desired shape through pressure. Accordingly, Applicant submits that Bambara does not teach or suggest claims 1 and 23-26 and that the rejection should be withdrawn.

Claims 23-26, 44, and 65 were rejected under 35 U.S.C. §102(b) as being anticipated by WO 99/52646 ("WO'646"). Applicants respectfully traverse this rejection for the following reasons.

The WO '646 reference does not teach or suggest a polymer article having the structural features of a polymer sheet including "a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern." As featured in claims 23-26 and 44 through independent claim 1. Similarly, with respect to independent claim 65, the cited reference does not teach or suggest "[a]n elongate foam strip" featuring "a surface pattern provided in an area that has been formed to a desired shape under pressure with a first partially compressed area and a second partially compressed area, compressed more or less than the first area." Specifically, the portions of WO'646 cited in the Office Action (i.e., page 4, lines 10-20, and Figs. 1-3) do not teach or suggest all of the claimed features of claims 1, 23-26, 44, and 65.

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As explained in Applicants' previous response, the cited sections of WO'646 relate to forming a foam strip from a foam web through cold-welded seams 3a, 3b from by compressing the web with rotary cutters to form the seams. Thus, WO '646 only teaches compressing to achieve a structure having the cold-welded seams created with pressure, and does not actually teach an article having a predetermined surface pattern with different areas compressed with varying degrees of compression to define a predetermined surface pattern. Accordingly, Applicant submits that WO'646 does not teach or suggest all of the features of claims 1, 23-26, 44 and 65 and that the rejection of these claims should be withdrawn.

Claims 23-26, 44, and 65 were further rejected under 35 U.S.C. §102(b) as being anticipated by WO 99/46056 ("WO'056"). Applicants respectfully traverse this rejection for the following reasons.

The referenced portions of WO'056 (i.e., page 1, lines 30-33, and Figs. 1A-1B) do not teach or suggest all of the claimed features of claims 1, 23-26, 44, and 65. No teaching or suggestion is given concerning a polymer sheet including "a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern" or "[a]n elongate foam strip" featuring "a surface pattern provided in an area that has been formed to a desired shape under pressure with a first partially compressed area, and a second partially compressed area, compressed more or less than the first area." Rather, WO '056 teaches forming masking materials through the use of crush cutting blades 6, such as by adhering two webs together using pressure from the rotary. The masking material structure taught does not, however, teach or suggest varied degrees of compressed areas of the material to achieve a predetermined surface pattern. Accordingly, Applicant submits that WO'056 does not teach or suggest all of the features of claims 1, 23-26, 44 and 65 and that the rejection of these claims should be withdrawn.

Claims 23-26, 44, and 65 were rejected under 35 U.S.C. §102(b) as being anticipated by Francis et al. (U.S. Patent No. 4,996,092). Applicants respectfully traverse this rejection based on the following comments.

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This reference is duplicative with the other references discussed above in that seams are created by using blunt rotary cutters by cold welding. Thus for the same reasons, this reference also fails to teach or suggest the claimed elements such as a polymer sheet including “a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern” or “[a]n elongate foam strip” featuring “a surface pattern provided in an area that has been formed to a desired shape under pressure with a first partially compressed area, and a second partially compressed area, compressed more or less than the first area.” Accordingly, Applicant submits that WO’056 does not teach or suggest all of the features of claims 1, 23-26, 44 and 65 and that the rejection of these claims should be withdrawn.

Claims 23-26, 44, and 65 were rejected under 35 U.S.C. §102(e) as being anticipated by Bouic (U.S. Patent No. 6,797,361). Applicants respectfully traverse this rejection for the same reasons presented above concerning the double patenting rejection using this same reference.

Claims 23-26, 44 and 65 were rejected under 35 U.S.C. §102(b) as being anticipated by EP 0 795 356 (EP ‘356), and alternatively under 35 U.S.C. §103(a) as obvious in light of EP 0 795 356. Applicants respectfully traverse this rejection as detailed below.

The Office Action asserts that EP ‘356 discloses or “strongly suggests” the claimed features of the rejected claims. Although EP ‘356 discloses a sealing and covering strip having a set shape, the reference does not teach or suggest a polymer sheet including “a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern” or “[a]n elongate foam strip” featuring “a surface pattern provided in an area that has been formed to a desired shape under pressure with a first partially compressed area, and a second partially compressed area, compressed more or less than the first area.” No teaching or suggest is given by EP ‘356 that the shape of the strip 100, 200, 300, or 400 includes areas of varied compression that thereby define the shape. Rather, the reference explicitly teaches merely

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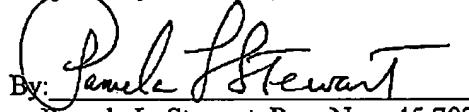
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cutting, sawing or milling the material to define the shape (see e.g., claim 19), which teaches away from using varied compression to achieve a desired surface pattern. Accordingly, Applicants respectfully submit that EP '356 does not teach or suggest all of the elements of claims 1, 23-26, 44, and 65 and that the rejection should be withdrawn.

Conclusion

Applicant asserts that claims 23-26, 44, and 65, as well as independent claim 1 are allowable over the prior art of record. Applicant requests reconsideration in view of the remarks above. Should the Examiner have any questions, please contact the undersigned.

Respectfully submitted,

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Date

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